

This Opinion is Not a
Precedent of the TTAB

Mailed: February 25, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TRUsox LLC

Serial No. 88931435

Ashok Tankha of Lipton, Weinberger & Husick for TRUsox LLC.

Christopher Hoffman, Trademark Examining Attorney, Law Office 128,
Travis Wheatley, Managing Attorney.

Before Shaw, Larkin, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Applicant, TRUsox LLC, seeks registration on the Principal Register of the stylized mark TRU, shown below (“Applicant’s Mark”), for “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Shoes; Socks; Ankle socks,” in International Class 25.¹

¹ Application Serial No. 88931435, filed on May 24, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as January 1, 2019. The mark is described as follows: “The mark consists of [sic] stylized word ‘TRU’ displayed on a white background.” Color is not claimed as a feature of the mark.

'TRU

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's Mark, as used in connection with these goods, so resembles the following registered marks, owned by different parties, as to be likely to cause confusion or mistake, or to deceive:

TRUE (standard character mark), for "golf shoes, footwear, socks, and hats," in International Class 25;²



, for "hats," in International Class 25;³ and

TRUE (standard character mark), for "clothing associated with a restaurant, namely, T-shirts and tank tops, and excluding any athletic wear, footwear, hats and gloves," in International Class 25.⁴

Citations in this opinion to the briefs and other docket entries refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

² Registration 4409630 (the "'630 Registration") issued on October 1, 2013; combined Sections 8 and 15 declaration accepted and acknowledged.

³ Registration 4891442 issued on January 26, 2016; combined Sections 8 and 15 declaration accepted and acknowledged.

⁴ Registration 6051280 issued on May 12, 2020.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal proceeded. We affirm the refusal to register.

I. Evidentiary Issue

First, we address an evidentiary issue. The Examining Attorney claims that Applicant submitted, for the first time on appeal, a list of seven third-party registrations, and for that reason, the seven registrations are not part of the record (6 TTABVue 3-4). Indeed, these seven third-party registrations were not a part of the record prior to appeal.

The record in the application should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal. If the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination.

Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). *See also In re Posthuma*, 45 USPQ2d 2011, 2012 n.2 (TTAB 1998) (third-party registration attached to appeal brief not considered). Accordingly, the list of registrations Applicant submitted with its brief were not timely filed.

In addition, Applicant did not properly make the listed registrations of record, even though the Examining Attorney noted, during prosecution, that the submission of a list of registrations was not the proper way to make those registrations of record.⁵ To make third-party registrations a part of the record, Applicant must submit copies

⁵ See Feb. 25, 2021 Final Office Action at TSDR 1.

of the registrations, or the complete electronic equivalent, prior to appeal. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2064 (TTAB 2013); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.02 (2021). The mere submission of a list of registrations on appeal does not make such registrations a part of the record. *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018) (citing *In re 1st USA Realty Prof'ls*, 84 USPQ2d 1581, 1583 (TTAB 2007)); TBMP § 1208.02. Consequently, we sustain the Examining Attorney's objection and will not consider the list of registrations.⁶

II. Likelihood of Confusion

Section 2(d) of the Trademark Act provides that an applied-for mark must be refused registration if it “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive” 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62

⁶ Applicant submitted the list of third-party registrations to support its discussion about the weakness of the cited marks. See 4 TTABVUE 13-14. Because this list of registrations was submitted for the first time on appeal, Applicant has no third-party registration evidence of record to support its argument as to the weakness of the cited marks.

(Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, *29 (TTAB 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)).

We focus our likelihood of confusion analysis on the ’630 Registration of the standard character mark, TRUE, for “golf shoes, footwear, socks, and hats,” in International Class 25. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *28 (TTAB 2020); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If we find a likelihood of confusion as to the ’630 Registration of TRUE and the goods identified therein, we need not find it as to the other registrations. Conversely, if we do not find a likelihood of confusion as to the ’630 Registration, we would not find it as to the other registrations for the goods identified therein.

A. The Similarity or Dissimilarity and Nature of the Goods and Channels of Trade

We begin with the *DuPont* likelihood of confusion factors regarding the similarity of the goods and channels of trade. Applicant’s goods are identified as “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms;

Shoes; Socks; Ankle socks.” Applicant’s “socks” and the “socks” identified in the ’630 Registration are identical. The identity of a single good identified in a cited registration and a single good from among multiple goods identified in a particular class in an application can sustain a finding of likelihood of confusion. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant’s “athletic apparel, namely ... footwear” encompasses the “golf shoes” identified in the ’630 Registration, whereas the broader “footwear” and “hats” identified in the ’630 Registration encompass Applicant’s “athletic apparel, namely ... footwear, hats.” Also, the “socks” identified in the ’630 Registration encompass Applicant’s “ankle socks.” These goods are in-part legally identical. *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1754 (TTAB 2009).

There are no limitations as to channels of trade or classes of purchasers in the goods identifications in the Application and the ’630 Registration. As a result, given the identical nature (in full or in part) of the goods, we must presume that the goods will be sold in the same channels of trade and bought by the same classes of purchasers. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1518-19 (TTAB 2016). The identity and legal identity of the goods causes this *DuPont* factor to weigh heavily in favor of finding a likelihood of confusion.

B. The Similarity or Dissimilarity of the Marks

Next we turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial

impression. *DuPont*, 177 USPQ 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord*, *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). We focus on the recollection of the average customer, who retains a general rather than specific impression of the marks. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018) (citations omitted); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014). And when the goods are identical or virtually identical, as is the case here, the degree of similarity between the marks required to support a finding of likelihood of confusion declines. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

Turning to a comparison of Applicant’s Mark, **TRU**, with the standard character mark TRUE of the ’630 Registration, we note that “likelihood of confusion is often found where the entirety of one mark is incorporated within another.” *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (citing *In re Denisi*, 225 USPQ 624,

626 (TTAB 1985) (PERRY'S PIZZA for restaurant services specializing in pizza and PERRY'S for restaurant and bar services)); *see also Coca-Cola Bottling Co. of Memphis Tenn., Inc. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ2d 105, 106 (CCPA 1975) (BENGAL and BENGAL LANCER for closely related goods found confusingly similar). Comparing the marks here, we find that TRUE incorporates the entire literal element of the Applicant's Mark, **'TRU**. TRUE is also a standard character registered mark without limitation on the manner of its display. For that reason we must assume that the registrant could display its TRUE mark in a stylization identical or similar to that of Applicant's Mark. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("[T]he rights associated with a standard character mark reside in the wording per se and not in any particular font style, size, or color.") (citing *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011)); *see also Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). The marks are similar in appearance.

In addition, we find that **'TRU** is a misspelled phonetic equivalent of the word "true" in the '630 Registration, so the marks could be pronounced the same. "Similarity in sound alone may be sufficient for a finding of likelihood of confusion." *1st USA Realty Prof'ls*, 84 USPQ2d at 1586 (citation omitted). The marks are similar, if not identical, in sound.

Applicant argues that no confusion is likely when its mark, **'TRU**, is used in conjunction with its house mark, TRUSOX, because use of those marks together creates a different commercial impression for **'TRU** (4 TTABVUE 3-4, 10). However,

marks are compared as they appear in the drawing of the application and in the registrations; the USPTO does not consider how an applicant actually uses their marks in the marketplace. *Aquitaine Wine USA*, 126 USPQ2d at 1186 (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Applicant cannot rely on extrinsic evidence to support its argument that the marks convey different commercial impressions. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *i.am.symbolic*, 123 USPQ2d at 1749). Consequently, Applicant's extrinsic use of its house mark with **TRU** is irrelevant here. The marks are similar, if not identical, in connotation and commercial impression because Applicant's mark is a misspelling of the word "true" in the '630 Registration.

Applicant further argues that the registered marks are all "currently coexisting peacefully" on the Register, so adding its mark to the Register would not cause confusion with the registered marks (4 TTABVUE 6). However, prior decisions and actions for other marks have little evidentiary value and are not binding on the Board or the USPTO. *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017).

Moreover, we do not find the mark shown in the cited registration to be weak and entitled to only a limited scope of protection, since Applicant did not make of record any evidence of use of the cited registered marks or any other third-party marks. Three registrations, without any evidence of use, is trivial when one considers the quantity and quality of evidence typically needed to find that marks, or portions of marks, in cited registrations are weak. *Compare Juice Generation, Inc. v. GS Enters.*

LLC, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (a “fair number of third-party uses of marks containing ‘peace’ and ‘love’ followed by a third, product-identifying term” was presented to the Board), *with Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“voluminous evidence of paw print design elements that [was] registered and used in connection with clothing” was presented to the Board), *and In re Joel Embiid*, 2021 USPQ2d 577, at *17-19 (TTAB 2021) (applicant presented no evidence of third-party use of PROCESS-formative marks, and only three third-party registrations of PROCESS-formative marks for clothing, which was “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant in both *Jack Wolfskin* and *Juice Generation*.”) (quoting *St. John’s*, 126 USPQ2d at 1746).

Overall, the phonetic equivalence and equivalence in meaning of the marks, and the fact that TRU is a misspelling of TRUE, lead us to conclude that Applicant’s Mark and the ’630 Registration are similar in sound, appearance, meaning, and commercial impression. This *DuPont* factor weighs in favor of a likelihood of confusion.

C. Purchaser Sophistication and Degree of Consumer Care

The last *DuPont* factor we consider pertains to the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the

opposite effect. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005).

Applicant asserts⁷ that purchaser care may tend to minimize any likelihood of confusion here because its consumers are nationally and internationally renown athletes “who would certainly make careful inquiry regarding quality and high cost of the product they are buying.” (4 TTABVUE 16). The cost of a pair of Applicant’s socks is \$45.00. *Id.*

The application and registrations in this case are not limited to professional purchasers of the goods, however, or to expensive goods used by elite athletes, including expensive socks. *See Sock It to Me, Inc. v. Fan*, 2020 USPQ2d 10611, at *7-8 (TTAB 2020) (Goods identified as “socks” include “all goods of the type identified, without limitation as to their nature or price,” and “are presumed to include socks that are relatively inexpensive.”). Moreover, where purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion*, 110 USPQ 2d at 1163). And the fact that some purchasers are sophisticated or knowledgeable in a particular field does not

⁷ Applicant also asserts that the Examining Attorney “erred in submitting no evidence demonstrating that the registered marks have acquired a level of fame and/or notoriety.” (4 TTABVUE 16). However, Applicant’s attempt to apply the fifth *DuPont* factor, “the fame of the prior mark,” is misplaced. The fifth factor is not normally applicable in ex parte proceedings, as the owner of the cited registration (“the prior mark”) is not a party to the ex parte appeal, and the Examining Attorney is under no obligation to demonstrate the fame of the cited registered mark. *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). So the “fame of the mark” factor generally is treated as neutral in an ex parte context. *See In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086-88 (TTAB 2016). The registered marks are treated as valid and entitled to the statutory presumptions afforded by Section 7(b) of the Trademark Act. 15 U.S.C. § 1057(b); *Fat Boys Water Sports*, 118 USPQ2d at 1517.

necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Cynosure, Inc.*, 90 USPQ2d 1644, 1647 (TTAB 2009).

In sum, the near identity of the marks and the identity of the goods “outweigh any presumed sophisticated purchasing decision.” *i.am.symbolic*, 123 USPQ2d at 1413. This *DuPont* factor is neutral.

III. Conclusion

When we consider the record, the relevant likelihood of confusion factors, and all of Applicant’s arguments relating thereto, we conclude that consumers familiar with the mark TRUE, shown in the ’630 Registration, would be likely to believe, upon encountering the identical clothing goods identified in the application to register Applicant’s Mark, **TRU**, that those goods originate from, are associated with, or are sponsored by, the owner of the ’630 Registration. As a result, confusion is likely between Applicant’s Mark and the mark shown in the ’630 Registration.

Decision: The refusal to register Applicant’s Mark, **TRU**, is affirmed.